



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,738	11/26/1999	AKIHIKO SATO	35.C14040	6641

5514 7590 01/30/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

VIDA, MELANIE M

ART UNIT PAPER NUMBER

2626

DATE MAILED: 01/30/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/449,738

Applicant(s)

SATO, AKIHIKO

Examiner

Melanie M Vida

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 11/4/03. Claims 1-19 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 3-6, 18** are rejected under 35 U.S.C. 102(b) as being anticipated by Hartrick et al. US Patent No. 5,428,529, (hereinafter, Hartrick).

Regarding, **claim 1**, Hartrick teaches an document manager system, as shown in figure 1, which reads on “an image processing apparatus”, (col. 5, lines 25-32). The printer prints a copyright notice and/or a security label on all pages, which reads on “rendering means for rendering image data”, after a copyright tag, [cpr] and security tag, [sec1], have been detected in the structured document, as shown in figure 3, which reads on “described using a description language”, (col. 2, lines 20-25; col. 6, lines 37-50; col. 10, lines 65 through col. 11, lines 9).

Art Unit: 2626

Hartrick inherently teaches of “a control means” as evidenced by figures 9a-9b, wherein if a user requests to print a document (300), that contains a special copyright string (304-307), printing will not continue (322) under the provision that a SEC1 flag (314) or a SEC2 (320) is found in the structured document, which reads on “for controlling printing of said image data according to the information relating to the copyright data detected by said detecting means”, (col. 6, lines 11-16; col. 10, lines 37-39; col. 10, lines 40-50; col. 10, lines 55-66).

Regarding, **claim 3**, Hartrick teaches that a method such as software, as shown in figure 9a-9b, which reads on “control means” wherein steps (314, 320) prohibit printing, which reads on “prohibits the printing”, (col. 6, lines 11-16; col. 10, lines 37-39; col. 10, lines 40-45; col. 10, lines 55-66).

Regarding, **claim 4**, Hartrick teaches a step (312), “PRINT COPYRIGHT STRING ON ALL PAGES” as shown in figure 9a, while at step (322), “DO NOT COPY: ABORT PRINT COMMAND”, which reads on “wherein said control means prohibits the output of said image data to a printer which performs the printing”.

Regarding, **claim 5**, Hartrick teaches a “YES” which reads on “a control means outputs a control signal” that causes step (322), as shown in figure 9b, that prohibits printing of data enclosed by a SEC2 Flag (320), which reads on “which gives said image data to a printer which performs the printing to prohibit the printing of said image data”.

Regarding, **claim 6**, Hartrick inherently teaches “identifying means” as evidenced by the steps in flowchart of figures 7a-7b, wherein if the user inputs a password, the password is validated as correct, then process flows to step (118), or if the password is incorrect, the process flows to step (116), that aborts any further operations, which reads on “for identifying a

Art Unit: 2626

password embedded in said image data, wherein said control means permits the printing of an image which corresponds to said image data when the same password as said password is input.”, (col. 8, lines 50-65).

Regarding, **claim 18**, please refer to the corresponding rejection in claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al. US Patent No. 5,428,529 as applied to claim 1 above, and further in view of Moskowitz et al. US Patent No. 5,745,569, (hereinafter, Moskowitz).

Regarding, **claim 2**, Hartrick teaches the image processing apparatus according to claim 1, but fails to specifically mention, “wherein the information relating to said invisible copyright data is digital watermark information”.

However, Moskowitz teaches in the background of the invention that digital watermarks can be used to identify the copyright holder, title, and licensed owner, which reads on “wherein the information relating to said invisible copyright data is digital watermark information”, (col. 1, lines 45-48).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify Hartrick's formatted copyright tag [cpr] with Moskowitz's digital watermark technology for invisible copyright information.

One of ordinary skill in the art would have been motivated to use digital watermark for copyright information in order to protect copyrights in the digital domain, given the express suggestion of Moskowitz, (col. 1, lines 5-11).

7. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al. US Patent No. 5,428,529 as applied to claim 1 above, and further in view of Chapman et al. US 2002/0057449 A1, (hereinafter, Chapman).

Regarding, **claim 7**, Hartrick teaches a keyboard (50), as shown in figure 1, which reads on "inputting means", and the steps in the flowchart of figures 7a-7b, wherein step (112), the user is prompted to enter a password, which reads on "for inputting a password by user". The apparatus has a communications adapter (48) as shown in figure 1, which reads on "receiving means" and a step (114) checks if the password is correct, as shown in step (114), or if it is incorrect, the ABORT step is activated (116), which reads on "for sending a password to an author's side device to receive information or print permission for said image formation".

Hartrick does not expressly disclose, ID detecting means for detecting ID information in order to identify said image data from said image data.

However, Chapman teaches that a program stored in memory in the printer, which reads on "ID detecting means", interprets a page description language (PDL), and detects an email addresses (step 47), as shown in figure 2, which reads on "detecting ID information in order to identify said image data from said image data", (paragraph 0011, lines 1-5).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify Hartrick's ID detecting means, with Chapman's printer to interpret an email address embedded in a page description language.

One of ordinary skill in the art would have been motivated to detect an email address embedded in a page description language in order for the printer to continue interpreting the page description file until completion (step 48), given the express suggestion of Chapman, (paragraph 0011, lines 6-9).

8. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al. US Patent No. 5,428,529 as applied to claim 1 above, and further in view of Daniele, US Patent No. 5,444,779, (hereinafter, Daniele).

Regarding, **claim 8**, Hartrick teaches the apparatus of claim 1, but does not expressly disclose the instructing means.

However, Daniele teaches a copyrights holders (240), as shown in figure 7, connected to a reproduction rights organization (220), which reads on "instructing means" coupled to a public use copier (250) where copying has been authorized, which reads on "for instructing acceptance for accounting for the printing using said image data to an author's side device, wherein said control means permits the printing of said image data in response to said instruction" (col. 8, lines 64-68).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Hartrick's apparatus with Daniele's instructing means.

One of ordinary skill in the art would have been motivated to use an instructing means in order to accept payment for copying a copyrighted document, given the express suggestion of Daniele's, (see figure 7).

9. **Claims 9, 11-12, 14-17, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniele US Patent No. 5,444,779, and further in view of Moskowitz et al. US Patent No. 5,745,569, (hereinafter, Moskowitz).

Regarding, **claim 9**, Daniele teaches an electronic copyright royalty accounting system, as shown in figure 2, which reads on "an image processing apparatus", (col. 6, lines 15-17). Further Daniele teaches of a glyph detector (30) for determining if the digitized document contains any embedded copyright data, which reads on detecting means for detecting image data, (col. 6, lines 40-42). Further, Daniele teaches that a local database (54) could periodically transmit or upload the copyright royalty information to databases of individual publishers or an RRO as represented by database (56), which reads on obtaining means for obtaining an address of a device which holds a data list relating to said image data from said detected digital information, (col. 8, lines 60-64). The advanced reprographic and printing systems could acquire the copyright royalty information or databases related to individual publishers, which reads on "receiving means for receiving the data list from the device according to said address obtained by said obtaining means", (col. 8, lines 56-63). As shown in figure 7, the public user copier (250) obtains the authorization to copy from the database (222) which reads on "data receiving means for receiving data selected by a user from said image data list". Daniele inherently teaches the inquiring means, as evidenced by "\$" in figure 7, transmitted from the public use copier (250) to the database (222), and the copyright holders (240), which reads on "for inquiring, prior to the

receiving by said receiving means, whether to perform the receiving by said receiving means by using said detected digital information.

Daniele does not expressly disclose a digital watermark.

However, Moskowitz teaches in the background of the invention that digital watermarks can be used to identify the copyright holder, title, and licensed owner, which reads on “wherein the information relating to said invisible copyright data is digital watermark information”, (col. 1, lines 45-48).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify Daniele’s image processing apparatus with Moskowitz’s digital watermark technology for invisible copyright information.

One of ordinary skill in the art would have been motivated to use digital watermark for copyright information in order to protect copyrights in the digital domain, given the express suggestion of Moskowitz, (col. 1, lines 5-11).

Regarding, **claim 11**, Daniele teaches that the glyph may include additional information so as to enable an electronic copying royalty accounting system capable of interpreting the encoded information to track and/or account for copyright royalties when they accrue during the reproduction of all or part of the original document, which reads on “said data list writes therein a plurality of data pieces and charge for said plurality of data pieces”, (col. 12, lines 35-39).

Regarding, **claim 12**, Daniele inherently teaches “said data reception is performed by selecting user’s desired data from said data list and inputting the number of a cash card of said user” as evidenced by a debit copy card (52), a scanner (22), a CD (24), a disk (26), to a document input device (20), as shown in figure 7.

Regarding, **claims 14-16**, please refer to the corresponding rejection of claim 9 and claim 10.

Regarding, **claim 17**, Daniele teaches that data can come from a publisher (56), and a local database (54), which reads on “said address comprises a plurality of addresses and said data receiving means receives a data list from a plurality of devices”, (see figure 2).

Regarding, **claim 19**, please refer to the corresponding rejection in claim 9.

10. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Daniele US Patent No. 5,444,779, and further in view of Moskowitz et al. US Patent No. 5,745,569, (hereinafter, Moskowitz), and further in view of Hartrick et al. US Patent No. 5,428,529, (hereinafter, Hartrick).

Regarding, **claim 10**, Daniele in view of Moskowitz teach the image processing apparatus according to claim 9, but they do not expressly disclose that the data is an image, speech or a movie.

However, Hartrick teaches a system wherein structured tags such as the parameter table (56), as shown in figure 5, invoke specialized functions for voice, video or document, which reads on “data is an image, speech or a movie”, (col. 6, lines 59 through col. 7, lines 6; col. 7, lines 39-48).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Daniele in view of Moskowitz image processing apparatus with Hartrick’s data.

One of ordinary skill in the art would have been motivated to use Hartrick's parameter data list in order to prevent illegal reproduction of all types of digital media available on the World Wide Web.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brassil et al. US Patent 6,086,706, finger-printing watermarks for preventing illegal distribution of copyright information.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie M Vida whose telephone number is (703) 306-4220. The examiner can normally be reached on 8:30 am 5:30 pm.

Art Unit: 2626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6743.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Melanie M Vida
Examiner
Art Unit 2626

MMV

mmv.

January 24, 2004

KA Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER